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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,248	07/19/2001	Biswa R. Banerjee	11465/491	9312

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Patent Administrator
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EXAMINER

BRIER, JEFFERY A

ART UNIT

PAPER NUMBER

2672

DATE MAILED: 12/20/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,248

Applicant(s)

BANERJEE ET AL.

Examiner

Jeffery A. Brier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6, 7 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 7 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Amendment

1. The amendment on line numbered 18 on the continuation transmittal form canceling claims 2-5, 8-10, 12 and 13 has been noted and entered.

Priority

2. This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a continuation of Application No. 08/300,500, filed 09/02/1994, now U.S. Patent No. 6,292,181." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of all nonprovisional parent applications referenced should be included.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1, 6, 7, and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 5, 6, and 8 of U.S. Patent No. 6,292,181. Although the conflicting claims are not identical, they are not patentably distinct from each other because this application's claims are broader than the patented claims and cover the patent invention. The following table correlates this application's claims to the patented claims.

Application claim number	Patent claim number
1	1
6	5
7	5
11	8

The following side by side analysis of claims 1, 6, 7, and 11 compares these claims and patented claims 1, 5, 6, and 8. It will be apparent that these claims have less limitations than the patented claims and the differences between these claims and the patented claims are underlined for the readers convenience.

Application claim number 1	Patented claim 1
1. A mobile user interface device for controlling a host computer, comprising:	1. A mobile user interface device for controlling a host computer, comprising:
a graphical display subsystem, including a graphical display, for displaying an image;	a graphical display subsystem, including a graphical display, for displaying an image;
an input subsystem, including a stylus, for receiving from a user positional data representing spatial positions of said stylus; and	an input subsystem, including a stylus, for receiving from a user positional data representing spatial positions of said stylus; and
a wireless communication subsystem for sending data to and receiving data from said host computer over a wireless communication link; and	a wireless communication subsystem for sending data to and receiving data from said host computer over a wireless communication link; and

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<p>Means for controlling operations of said graphical display subsystem,</p> <p>said input subsystem and said wireless communication subsystem, said means for controlling (i) causing said wireless communication link to be created;</p> <p>(ii) causing an application program to be run on said host computer;</p> <p>(iii) receiving from said input subsystem said positional data, providing a response to said user in acknowledgment of said positional data, and transmitting over said wireless communication link said positional data to said application program; and</p> <p>(iv) receiving over said wireless communication link from said application program data representing said image, and causing said graphical display subsystem to display said image on said graphical display.</p>	<p>means for controlling operations of said graphical display subsystem,</p> <p>said input subsystem and said wireless communication subsystem, said means for controlling (i) causing said wireless communication link to be created;</p> <p>(ii) causing an application program to be run on said host computer;</p> <p>(iii) receiving from said input subsystem said positional data, providing a response to said user in acknowledgment of said positional data, and transmitting over said wireless communication link said positional data to said application program; and</p> <p>(iv) receiving over said wireless communication link from said application program data representing said image, and causing said graphical display subsystem to display said image on said graphical display</p>
	<p>: wherein said means for controlling comprises:</p> <p><u>a central processing unit;</u></p> <p><u>a processor bus coupled to data and address terminals of said central processing unit;</u></p> <p><u>a memory subsystem accessible by said central processing unit over said processor bus;</u></p> <p><u>a peripheral bus coupled to said input device subsystem, said graphical display subsystem and said wireless communication subsystem;</u></p> <p><u>a system controller unit, coupled to said processor and peripheral busses and under the control of said central processing unit, for controlling over said peripheral bus the operations of said input device subsystem, said graphical subsystem, and said wireless communication subsystem.</u></p>

Application claim number 6	Patented claim 5
6. A computer system comprising: a hand-held interface devices comprising (i) a display device; (ii) a position input device; (iii) a wireless receiver and transmitter circuit; and (iv) control means for providing an image on said display device; and a host computer being coupled to (i) a wireless receiver and transmitter circuit for communicating with said hand held interface device; and (ii) means for modifying said image.	5. A computer system comprising: a hand-held interface device comprising (i) a display device; (ii) a position input device, <u>said position input device receiving positional data representative of a current location of said position input device;</u> (iii) a wireless receiver and transmitter circuit, <u>said wireless receiver and transmitter circuit transmitting said positional data;</u> and (iv) control means for providing an image on said display device; and a host computer being coupled to (i) a wireless receiver and transmitter circuit for communicating with said hand held interface device, <u>said wireless receiver and transmitter circuit of said host computer receiving said positional data;</u> and (ii) means for modifying said image in <u>accordance with said positional data;</u> <u>wherein said wireless receiver and transmitter circuit is accessed by said host computer as a shared resource on a local area network, and said position input device provides a plurality of data points each indicating a position of said position input device relative to an origin, said data points being queued in a pen event buffer in said hand held interface device for transmission to said host computer over a wireless link established between said wireless receiver and transmitter circuit of said hand held interface device and said wireless receiver and transmitter circuit coupled to said host computer.</u>

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Application claim number 7	Patented claim 5
7. A computer system as in Claim 6,	5. A computer system comprising:
See the above comparison of claim 6 and patented claim 5.	<p>a hand-held interface device comprising</p> <p>(i) a display device;</p> <p>(ii) a position input device, <u>said position input device receiving positional data representative of a current location of said position input device;</u></p> <p>(iii) a wireless receiver and transmitter circuit, <u>said wireless receiver and transmitter circuit transmitting said positional data;</u> and</p> <p>(iv) control means for providing an image on said display device; and</p> <p>a host computer being coupled to</p> <p>(i) a wireless receiver and transmitter circuit for communicating with said hand held interface device, <u>said wireless receiver and transmitter circuit of said host computer receiving said positional data;</u> and</p> <p>(ii) means for modifying said image in <u>accordance with said positional data;</u></p>
wherein said wireless receiver and transmitter circuit is accessed by said host computer as a shared resource on a local area network.	wherein said wireless receiver and transmitter circuit is accessed by said host computer as a shared resource on a local area network, and
	<u>said position input device provides a plurality of data points each indicating a position of said position input device relative to an origin, said data points being queued in a pen event buffer in said hand</u>

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	<u>held interface device for transmission to said host computer over a wireless link established between said wireless receiver and transmitter circuit of said hand held interface device and said wireless receiver and transmitter circuit coupled to said host computer.</u>
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Application claim number 11	Patented claim 8
11. A method for providing a mobile user interface device, comprising <u>the steps of:</u>	8. A method for providing a mobile user interface device, comprising:
providing a graphical display;	providing a graphical display;
providing an input device for indicating locations on said graphical display; and	providing an input device for indicating locations on said graphical display;
providing a wireless transceiver for communicating display information from said host computer to said mobile user interface device and for communicating said locations from said mobile user interface device to said host computer; and	providing a wireless transceiver for communicating display information from said host computer to said mobile user interface device and for communicating said locations from said mobile user interface device to said host computer;
sending data representing said locations to said host computer over said wireless link.	sending data representing said locations to said host computer over said wireless link; and
	<u>interpreting in said host computer said locations as representing digitized strokes of a handwriting.</u>

From the above comparisons it is clear that the pending claims are broader versions of the patented claims. Broader versions of patented claims are an obvious way for applicant to claim the same thing patented. *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 623 (CCPA 1970). *Vogel* stated on page 623 "The answer to the second analysis question, therefore, is yes, and the claim is not allowable in the absence of a terminal disclaimer. The correctness of this conclusion is demonstrated by observing that claim 10, by reciting "meat," includes pork. It is further noted that viewing the inventions in

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reverse order, i.e. as though the broader claims issued first, does not reveal that the narrower (pork) process is in any way unobvious over the broader (meat) invention disclosed and claimed in the instant application.” Thus, this application’s broader claims are not unobvious over the above identified patented claims.

5. Claims 1, 6, 7, and 11 correspond to the rejected claims in parent application 08/300,500 whose rejection was affirmed by the United States Board of Patent and Trademark Appeals. The Board’s reasons for affirming the rejections based upon the McCain reference are incorporated by reference. A copy of that decision is attached. The Board affirmed rejections set forth in the examiners answer in parent application 08/300,500 is reproduced below.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 1, 6, 7, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by McCain, U.S. Patent No. 5,309,351. This reference with an effective filing date of

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October 27, 1988 describes a portable touch screen display which uses an infrared link as a connection to a host computer which performs application processing and provides display information to the portable touch screen display via the infrared link. Especially note column 7 lines 30-33 and lines 58-60 and column 9 lines 46-47 and column 10 lines 41-46 which describes a portable unit constructed of a minimum of parts with limited processing capability. Also note In re Graves, 36 USPQ2d 1697, 1701 (CAFC December 4, 1995) which teaches that fundamental technical information known to one of ordinary skill in the art need not be explicitly taught by the reference for the reference to show that the claimed invention is old under 35 U.S.C. § 102.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (703) 305-4723. The examiner can normally be reached on M-F from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231


or faxed to:

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(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


Jeffery A Brier
Primary Examiner
Art Unit 2672

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

MAILED

OCT 27 2000

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BISWA R. BANERJEE, S. CHRISTOPHER GLADWIN, ARIF MASKATIA
and ALAN SOUCY

Appeal No. 1998-0943
Application No. 08/300,500

ON BRIEF

Before THOMAS, HAIRSTON, and RUGGIERO, Administrative Patent
Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-13, all of the claims pending in the present application. An amendment after final rejection filed March 5, 1999, was entered by the Examiner. In the Examiner's Answer, the Examiner indicated that claims 2, 3, and 5 were allowable. Accordingly, only the rejection of claims 1, 4, and 6-13 is before us on appeal.

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The disclosed invention relates to a mobile interface device which operates to remotely control application programs running on a host computer. An input subsystem, including a stylus, provides positional data representing spatial positions of the stylus. A further embodiment includes a pen-based graphical interface which communicates with an operating system on the host computer having handwriting recognition capability.

Claim 1 is illustrative of the invention and reads as follows:

1. A mobile user interface device for controlling a host computer, comprising:

a graphical display subsystem, including a graphical display, for displaying an image;

an input subsystem, including a stylus, for receiving from a user positional data representing spatial positions of said stylus; and

a wireless communication subsystem for sending data to and receiving data from said host computer over a wireless communication link; and

means for controlling operations of said graphical display subsystem, said input subsystem and said wireless communication subsystem, said means for controlling (i) causing said wireless communication link to be created; (ii) causing an application program to be run on said host computer; (iii) receiving from said input subsystem said positional data, providing a response to said user in acknowledgment of said positional data, and transmitting over said wireless communication link said positional data to said application program; and (iv) receiving over said wireless communication link from said application program data representing said image, and causing said graphical

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display subsystem to display said image on said graphical display.

The Examiner's Answer cites the following prior art:

More et al. (More)	5,194,852	Mar. 16, 1993
McCain et al. (McCain)	5,309,351	May 03, 1994
Kannan et al. (Kannan)	5,423,045	Jun. 06, 1995

(Filed Apr. 15, 1992)

Mark Weiser (Weiser), "The Computer for the 21st Century,"
Scientific American, pages 94-104 (September 1991).

Claims 1 and 6-11 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by McCain.¹ Claims 4, 12, and 13 stand finally rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers McCain in view of More with respect to claims 4 and 12, and McCain in view of Kannan with respect to claim 13.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs² and Answer for the respective details thereof.

¹ Although the Examiner makes reference to the Weiser publication in the "Response to argument" portion of the Answer, the statement of the grounds of rejection relies on McCain alone.

² The Appeal Brief was filed July 21, 1997. In response to the Examiner's Answer dated October 9, 1997 (remailed January 11, 1999), Appellants submitted a Reply Brief on March 5, 1999 which was entered by the Examiner as indicated in the communication dated March 31, 1999.

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OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the disclosure of McCain fully meets the invention as recited in claims 1, 6, 7, 9, and 11. We reach the opposite conclusion, however, with respect to claims 8 and 10. We are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention set forth in claims 4, 12, and 13. Accordingly, we affirm-in-part.

We consider first the rejection of claims 1 and 6-11 under 35 U.S.C. § 102(e) as anticipated by McCain. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every

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element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Assoc, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claim 1, the Examiner's analysis (Answer, pages 4 and 7) suggests how the various limitations are disclosed by McCain. In particular, the Examiner points to a discussion beginning at column 6, line 56 in McCain relating to the interactive operation between the hand-held unit and the host computer.

In response, Appellants' primary argument (Brief, pages 10 and 11) centers on the alleged failure of McCain to disclose that the hand-held unit provides a response to the user in acknowledgment of received positional data from the input subsystem as recited in appealed claim 1. We do not find such argument to be persuasive. Positional information is received by McCain's hand-held unit through operation of a touch screen input feature. As discussed at col. 1, line 66 to col. 2, line 2 of McCain, "[a] Display Touch Scanner is used to scan the surface of

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the display to determine where and when the display has been touched, to provide touch input to the system, and to control the operation sequence for various applications of the invention" (emphasis added). McCain does not provide an explicit disclosure of an acknowledgment to a user in response to the input of positional data. We note, however, that, although McCain may not spell out every detail of the claimed invention, a reference anticipates a claim if it discloses the claimed invention "such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), quoting from In re LeGrice, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962). In our view, the skilled artisan would appreciate that any touch screen input device would require an acknowledgment feature to verify, for example, that actual contact was made with the screen. McCain is not required to specifically disclose such acknowledgment feature in order to be an anticipatory reference because such a user notification feature would be present in any system with a touch screen input feature. As further evidence of the recognition to a skilled artisan of the inclusion of user acknowledgment features in touch screen input devices, we cite the following

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excerpt from Computer Dictionary, Second Edition, published by Microsoft Press (copy enclosed) in which "touch screen" is defined in part as "[a] computer screen designed or modified to recognize the location of a touch on its surface. By touching the screen, the user can make a selection or move a cursor." Even in the limited example provided by this definition, the movement of the cursor would provide an acknowledgment to the user of positional input data provided by the location of the "touch" on the screen. We further point to the example provided at column 8, lines 10-20 in McCain in which the display of operating parameters of a "touched" part of displayed diagram of a process would serve as an acknowledgment to the user of the location (position) of the "touch".

For the reasons discussed above, we sustain the Examiner's rejection of independent claim 1 as being anticipated by the disclosure of McCain.³

³The use of a dictionary definition of a standard reference work cited to support a fact judicially noticed is not considered a new ground of rejection. In re Boon, 439 F. 2d 724, 7227, 169 USPQ 231, 234 (CCPA 1971). With respect to the Weiser publication discussed by the Examiner in the "Response to argument" portion of the Answer, we, along with Appellants, are puzzled as to the relevance attributed to this reference by the Examiner. Since we find, however, that McCain discloses all of the limitations of appealed claim 1, any discussion of the merits of Weiser is moot.

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Turning to a consideration of the Examiner's 35 U.S.C. § 102(e) rejection of independent claims 6 and 11 as being anticipated by McCain, we sustain the rejection of these claims as well. The limitations of claims 6 and 11 are directed to the wireless transfer of positional information from the hand-held interface device to the host computer with claim 6 additionally reciting the modification of images on the display of the hand-held device by the host computer. After reviewing the McCain reference, we agree with the Examiner's position (Answer, pages 8 and 9) that all of the limitations of appealed claims 6 and 11 are disclosed by McCain. In our view, McCain's disclosure of the wireless communication of touch screen positional data from the hand-held unit to the host computer and the subsequent control of the presentation of input menu choice screen images on the display of the hand-held unit (e.g. McCain, column 7, lines 11-13) meets all of the requirements of claims 6 and 11.

After reviewing Appellants' arguments with respect to the Examiner's rejection of claims 6 and 11 at page 13 of the Brief, it is our opinion that such arguments are not commensurate with the scope of claim 1. It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the

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specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Appellants contend that McCain does not disclose the provision of a response to a user's positional input "prior to receiving subsequently image modification generated by the application program running on the host computer." In our view, even assuming, arguendo, that such response sequence language would distinguish over McCain, no such language exists in the claims. In view of the above, since all of the limitations of independent claims 6 and 11 are disclosed by McCain, the Examiner's 35 U.S.C. § 102(e) rejection of claims 6 and 11 is sustained.⁴

Dependent claims 7 and 9 have not been separately argued by Appellants. Accordingly, these claims will be treated as falling

⁴ The recitations "said host computer" at line 6 of claim 11 and "said positional and selection data" at line 3 of claim 13 lack clear antecedent reference.

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with their parent claim 6. See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); and In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978). Thus, it follows that the examiner's rejection of claims 7 and 9 under 35 U.S.C. § 102(e) is also sustained.

After considering the entirety of the Appellants' comments directed to the McCain reference, however, we find Appellants' arguments to be persuasive with respect to dependent claim 8. We note that the limitations of dependent claim 8 are directed to the queuing of plural positional data points in a pen event buffer in the hand held interface device. Like Appellants, we do not find such a feature disclosed by McCain. While the Examiner suggests (Answer, page 9) the inherent nature of buffers for queuing data points, no support on the record has been provided to support such a conclusion. To establish inherency, evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and would be recognized as such by persons of ordinary skill. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) citing Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency,

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however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. citing Continental, 948 F.2d at 1269, 20 USPQ2d at 1749.

Accordingly, the Examiner's 35 U.S.C. § 102(e) rejection of dependent claim 8, as well as claim 10 dependent on claim 8, is not sustained.

Turning to the obviousness rejection of claims 4, 12, and 13, we note that in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825

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(1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to dependent claims 4 and 12, the Examiner, as the basis for the obviousness rejection, proposes to modify the wireless communication system disclosure of McCain by relying on More to supply the missing teaching of providing handwriting recognition to the host computer "so detailed user input may be detected by the system" (Answer, page 5).

In response, Appellants assert (Brief, page 16) that the Examiner has failed to establish a prima facie case of obviousness since proper motivation for the Examiner's proposed combination has not been set forth. We agree. It is our opinion that the Examiner has combined the general teachings of the handwriting recognition system of More with the touch screen input system of McCain in some vague manner without specifically describing how the teachings would be combined. This does not

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persuade us that one of ordinary skill in the art having the references before her or him, and using her or his own knowledge of the art, would have been put in possession of the claimed subject matter.

Further, we are cognizant of the Examiner's assertion (Answer, page 5) as to the conventionality of using handwriting input and recognition techniques as display user interface features. Notwithstanding the merits of this contention, however, we find no convincing reasoning supplied by the Examiner as to how and why the skilled artisan would apply such handwriting recognition features to the system described in McCain. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). We are left to speculate why the skilled artisan would modify the touch screen input subsystem of McCain with the handwriting recognition teachings of More. The only reason we can discern is improper hindsight reconstruction of Appellant's claimed invention. Accordingly, the Examiner's 35 U.S.C. § 103 rejection of dependent claims 4 and 12 is not sustained.

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Further, we find the Examiner's line of reasoning to be similarly deficient with respect to the power conservation features of claim 13 and, therefore, we also do not sustain the obviousness rejection of this claim. In our view, any combined structure resulting from the Examiner's proposed combination of the generalized power conservation features of Kannan and the wireless communication system of McCain would not address the specific limitations of claim 13 which set forth specific "out-of-range" criteria for input positional and selection data.

In summary, we have sustained the Examiner's 35 U.S.C. § 102(e) rejection of claims 1, 6, 7, 9, and 11, but have not sustained the 35 U.S.C. § 102(e) rejection of claims 8 and 10. Further, we have not sustained the Examiner's 35 U.S.C. § 103 rejection of claims 4, 12, and 13. Therefore, the Examiner's decision rejecting claims 1, 4, and 6-13 is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JAMES D. THOMAS
Administrative Patent Judge

KENNETH W. HAIRSTON
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

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